

REMARKS

Claims 1 – 23 were originally filed. Claims 4, 16 – 23 have been withdrawn from consideration. Claims 1 – 3, 5 – 15 are currently pending in the application. This amendment cancels claims 6 and 9 and amends claims 1, 10 – 15. Claim 24 has been added.

Amendment to the Specification

Applicants have by this Amendment and Response substituted paragraph [0033] of the Specification. The substituted paragraph elaborates upon the function and placement of the system-monitoring sensors and switches disclosed in the original paragraph. No new matter has been added.

Election / Restrictions

The Examiner requested confirmation of a provisional election made without traverse on September 22, 2004 during a telephone conversation with the undersigned attorney for Applicants. Applicants hereby affirm the election without traverse to prosecute the invention of Group I and Species I, claims 1 – 3 and 5 – 15.

Rejections of Claims under 35 U.S.C. § 112, Second Paragraph

Claims 1 – 3, 5 – 8 and 11 – 15 were rejected as indefinite for omitting an essential element. By the foregoing amendments, the missing element of “a transport pipe to transport removed material out of the system” has been added.

Claim 6 is rejected as being indefinite for failing to particularly point out how it further limits the claimed structure. Claim 6 has been cancelled. The rejection is therefore rendered moot.

The Examiner claims 11-12 are rejected as being indefinite for failing to particularly point out how it further limits the claimed structure. By the foregoing amendment to claim 11, Applicants have pointed out that the material removal system is one that is consistently run rather than one that may be intermittently turned on or off. Further, Applicants have pointed

out that the actual removal of the materials is activated only when the material being removed reaches a threshold thickness. Dependant claim 12 benefits from this amendment. Because the claimed structure is clear, Applicants respectfully request that the Examiner remove the rejection.

The Examiner rejects claims 13-15 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By the foregoing amendment, Applicants have clearly pointed out that the sensors in claim 13 are positioned in the tank and are useful in monitoring the system and preventing spillage. The amendment also clarifies the subject matter of dependant claim 14. Similarly, amended claim 15 now points out that the remotely operated switches trigger drainage from the tank. Since the claims now clearly point to the subject matter that is the invention, Applicants respectfully request the withdrawal of the rejection.

Claims 13 – 15 are additionally criticized as for failing to particularly point out how they further limit the claimed structure. Applicants disagree. The basic structure as recited in claims 1 and 5, from which claims 13 – 15 depend, includes neither sensors nor remotely operated switches. Claim 13 recites a structure with sensors positioned in the tank to monitor the system's functions or the environmental conditions of the site where the system is situated to prevent spillage. Claim 14 further limits these sensors to ones that are capable of being monitored remotely, i.e. sensors that are capable of sending signals or data across space. Claim 15 recites the added structure of switches that may be controlled remotely to trigger drainage. Because each claim clearly points out the additional limitations to the system of claim 1, Applicants respectfully request that the rejection be withdrawn.

Rejections of Claims under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 11 and 12 for failing to comply with the enablement requirement because the Applicants have not disclosed how the subject matter of the claims are accomplished. Applicants respectfully disagree.

Claim 11 and 12 discuss the how the material remediation system of the invention removes the material in question. This subject matter is disclosed in paragraphs 0021, 0022, and 0026 of the specification. Specifically, paragraph 0026 introduces the concept that the system is continuous. Paragraph 0021 discloses the characteristic of “threshold thickness” of the material, and that the material won’t be removed until the threshold thickness is achieved and the material flows into the intake port or hole in the float. Paragraph 0022 sheds light on the function of the system. In short, the system, when powered, continually asserts a pulling force through the tubing and the float. However, the material will not be removed until it reaches a threshold thickness based on the density of the fluid and the size of the float. Once the threshold thickness is achieved, the material will flow into the float and tubing through the intake port or hole to be transported away.

Applicants contend that one skilled in the art, looking at the specification and claims 11 and 12, will readily understand how to make and use the invention. Withdrawal of the rejection is respectfully requested.

Drawings

The Examiner has objected to the drawings and required Applicants to submit amended drawings that indicate the sensor(s) as claimed in claims 13 and 14 be shown. Applicants hereby submit the corrected drawings of Figure 1, which show the position of the sensors as required. The replacement sheet is attached hereto as Exhibit A.

Specifically, Figure 1 now shows the position in the tank of the low, high, and high-high sensors, labeled 410, 412, and 414 respectively. The control box or panel 418 to which the sensors are connected either physically or remotely is also shown. Likewise is shown a switch 416 in the control box or panel. The valve 420, which is triggered by the switch, is also shown.

As the presence of these sensors and switches, and the control mechanisms are disclosed in the specification, no new matter has been added. A formal replacement drawing of Figure 1 will be submitted when it becomes available.

Rejection under 35 U.S.C. §102(b)

35 U.S.C. §102(b) provides, in pertinent part: “a person shall be entitled to a patent unless: (b) the invention was first patented . . . in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States.” The Examiner has rejected claims 1, 2, 5, 6 and 9 pursuant to this statute as being anticipated by U.S. Pat. No. 5,474,685 to Breslin. The Examiner refers in particular to the recovery unit 2 and the pump 26. Claims 6 and 9 have been cancelled. Applicants respectfully traverse the rejection of the remaining claims.

For a claim to be anticipated, the prior art reference must show each and every element as set forth in the claim. MPEP §2131. Breslin teaches a system of separating two fluids where a pressure-regulated and sensor-activated pump that is connected to a floating device by a tubing pumps out a fluid with a lesser specific gravity than the remaining fluid. The similarities between the inventions end there.

Notably, the transport pipe of the invention also functions as a pump rod. While Breslin teaches a conduit that carries the removed fluid into a fluid receiver (Breslin, Col. 7, lines 38-40), the conduit does not function as a pump rod. Breslin’s failure to teach this feature renders it ineffective as anticipatory prior art.

In short, the transport pipe-cum-pump rod unit distinguishes the present invention from the Breslin invention. Accordingly, claim 1 is patentable over Breslin, and so too are claims 2 and 5, which depend thereon. Applicants therefore respectfully request the withdrawal of the rejection to claims 1, 2, and 5.

Rejection Under 35 U.S.C. §103(a)

Claims 7, 13 – 15 are rejected under 35 U.S.C. §103 (a) as obvious over Breslin. In addition, claim 3 is rejected as obvious over Breslin in view of U.S. Pat. No. 4,249,867 to Cunningham. Applicants respectfully traverse this rejection.

With respect to the rejection of claims 7, 13 – 15, even accepting that one skilled

in the art would have known to use HDPE rather than polypropylene as well as to use sensors for monitoring, Applicants contend that the combination of these “obvious” alternatives would not have resulted in the Applicants’ invention. Even if the Breslin float were made of HDPE, it would still be distinguishable from the present invention in that it requires bore holes, mechanical fittings and conduit to pressure sensors. Similarly, the addition of sensors to monitor level, etc., would still result in a sensor-controlled removal system – quite unlike the present invention. More importantly, nothing in the Breslin patent would prompt or suggest one skilled in the art to use these alternatives.

With respect to the rejection against claim 3, Applicants again submit that the combination of the Cunningham teaching – the use of a windmill to power a pump – with Breslin’s teaching would not result in the Applicants’ invention. The combination would lead to a sensor-activated and deactivated pump which relies on the windmill as a source of power. As stated above, the present invention does not rely on sensors to activate or deactivate the pump. There is also nothing in Breslin to suggest or to motivate one skilled in the art to combine it with a windmill as a power source.

For these reasons, Applicants urge the Examiner to remove the rejection under § 103(a) against claims 3, 7, and 13 – 15.

Newly added claim 24

By the foregoing amendment, Applicants have added new independent claim 24. Claim 24 additionally calls for a continuously run system where material removal is activated only when the material being removed reaches a threshold thickness. The concept of material removal directly triggered by a threshold thickness of the material to be removed is not taught in either Breslin or Cunningham. As such, the claim is free of the cited art and is in condition for allowance.

Conclusion

In so far as the above amendments and remarks have addressed fully the Examiner's rejections, the instant application is seen to be in condition for allowance. In view of the foregoing, withdrawal of the Examiner's rejections and issuance of a Notice of Allowance of all pending claims is therefore respectfully requested.

Respectfully submitted,
SCHNADER HARRISON SEGAL & LEWIS, LLP

By: 

Joan T. Kluger

Registration No. 38,940

Stephenie W. Yeung

Registration No. 48,052

1600 Market Street, Suite 3600

Philadelphia, PA 19103

Direct Dial: (215) 751-2357

Facsimile: (215) 751-2205

E-mail: jkluger@schnader.com

Attorneys for Applicant